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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,578	10/30/2003	Scott Kevin Maxwell	030253-3	7197
22204	7590	01/09/2006	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			DUNHAM, JASON B	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,578	Applicant(s) MAXWELL, SCOTT KEVIN	
	Examiner Jason B. Dunham	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-8,11-20,23-24,27-30,33-34, and 37-38 are rejected under 35

U.S.C. 102(e) as being anticipated by Horstmann (U.S. Patent No. 6,363,356).

Referring to claim 1. Horstmann discloses a method for purchasing software online, comprising:

- Enabling a software purchase transaction for a computing device, while the computing device is offline (Horstmann: column 4, lines 4-21). The examiner notes that Horstmann discloses installing software from a local source on the end user machine and paying for the product at a later date through a web site.
- Completing the software purchase transaction, when the computing device goes online (Horstmann: column 4, lines 4-21).

Referring to claim 3. Horstmann further discloses a method comprising:

- Providing a software distributor relationship between a vendor and a software distributor of the software (Horstmann: abstract);

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- Enabling revenue distribution between the vendor and the software distributor for the software purchased on the computing device (Horstmann: abstract & figure 1).

Referring to claim 4. Horstmann further discloses a method comprising adding a resource to the software purchased on the computing device for specifying the revenue distribution between the vendor and the software distributor (Horstmann: abstract & figure 1).

Referring to claim 5. Horstmann further discloses a method comprising:

- Providing a software development tool provider relationship between a vendor and a software development tool provider (Horstmann: column 1, lines 28-44);
- Enabling revenue distribution between the vendor and the software development tool provider for a software development tool used in the creation of the software purchased on the computing device (Horstmann: column 1, lines 28-44).

Referring to claims 6-8. Claims 6-8 are rejected under the same rationale set forth above.

Referring to claim 11. Horstmann further discloses a method comprising:

- Developing the software for purchase on the computing device³ (Horstmann: column 1, lines 28-44). The examiner notes that Horstmann discusses software publishers who must inherently develop the software in order to publish it.
- Distributing the developed software to the computing device (Horstmann: abstract).

Referring to claim 12. Horstmann further discloses a method comprising:

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- Providing an interface for application programming in software for purchase of the application on the computing device from within the application (Horstmann: column 2, lines 28-35); and
- Distributing the software to the computing device (Horstmann: column 2, lines 36-61).

Referring to claim 13. Claim 13 is rejected under the same rationale set forth above.

Referring to claim 14. Horstmann further discloses a method comprising not storing the purchasing information external to the computing device (Horstmann: abstract).

Referring to claim 15. Horstmann further discloses a method comprising:

- Storing a software registration key for the software purchased for the computing device (Horstmann: column 2, lines 36-61); and
- Distributing the stored software registration key to the computing device online (Horstmann: column 2, lines 36-61).

Referring to claim 16. Horstmann further discloses a method comprising:

- Prompting a user of the software to confirm a refund request from within the software (Horstmann: column 1, lines 27-44). The examiner notes that Horstmann discloses the well known method buy/try wherein software may be returned for a refund within a set period of time.
- Disabling the software before sending a refund authorization to a service provider of the software (Horstmann: column 1, lines 27-44).

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Referring to claim 17. Horstmann further discloses a method comprising:

- Confirming a return of the purchased software (Horstmann: column 1, lines 27-44); and
- Deactivating the software, if the return is confirmed by a user of the software (Horstmann: column 1, lines 27-44).

Referring to claim 18. Horstmann further discloses a method comprising:

- Providing a site license for the software purchased for the computing device (Horstmann: column 2, lines 36-61); and
- Distributing the site license to the computing device (Horstmann: column 2, lines 36-61).

Referring to claim 19. Horstmann further discloses a method comprising:

- Configuring the site license as a generic license for the software purchased for the computing device (Horstmann: column 2, lines 36-61).
- Converting the generic license to a device specific license for the computing device (Horstmann: column 2, lines 36-61). The examiner notes that Horstmann discloses a license information file that is customized for each specific product.

Referring to claim 20. Claim 20 is rejected under the same rationale set forth above.

Referring to claims 23-24 and 27-28. Claims 23-24 and 27-28 are rejected under the same rationale set forth above.

Referring to claims 29-30. Claims 29-30 are rejected under the same rationale set forth above.

Referring to claims 33-34 and 37-38. Claims 33-34 and 37-38 are rejected under the same rationale set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (U.S. Patent No. 6,363,356) in view of Reisman (U.S. Patent No. 6,594,692).

Referring to claims 2 and 9-10. Horstmann discloses all of the above but does not expressly disclose correcting mis-entered information or communicating updates or purchasing incentives. Reisman discloses:

- Correcting mis-entered information relating to the software purchase for the computing device, while the computing device is offline (Reisman: column 8, lines 6-17);
- Communicating one of software updates, price updates, software upgrades, and purchasing incentives, when the computing device goes online (Reisman: abstract & column 12, lines 14-26).

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- Providing one of a coupon, up-selling, and special offer mechanism for the software purchased on the computing device (Reisman: abstract & column 12, lines 14-26); and
- Distributing the coupon when accessing the software on the computing device (Reisman: abstract & column 12, lines 14-26).
- Displaying the coupon when accessing the software on the computing device (Reisman: abstract & column 12, lines 14-26).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Horstmann, to have corrected mis-entered information or communicated updates or purchasing incentives, as taught by Reisman, in order to assist in automating software updates (Reisman: abstract).

Claims 21-22,25-26,31-32, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (U.S. Patent No. 6,363,356) in view of Stefanik (U.S. Patent Application Publication No. 2003/0163382).

Referring to claims 21-22, 25-26, 31-32, and 35-36. Horstmann discloses all of the above but does not expressly disclose a method or system wherein the computing device is handheld device including a Palm Operating System. Stefanik disclose a method and system for distributing software on handheld devices that include a Palm Operating System (Stefanik: abstract & paragraph 45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method and system of Horstmann to have included software distribution on handheld

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devices with a Palm Operating System, as taught by Stefanik, in order to expand the software distribution (Stefankik: paragraph 45).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD
Patent Examiner
12/28/05


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